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EXAMINER

DASS, HARISH T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/086,406	Applicant(s) BECK ET AL.	
	Examiner HARISH T. DASS	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-156 is/are pending in the application.
- 4a) Of the above claim(s) 27-80 and 106-152 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 81-105 and 153-156 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's communication of 6/1/2010.

2. **Priority:** 03/01/2002

3. **Status of claims:**

Claims 1-26, 81-105 and 153-156 are pending (claims 2-11 and 82-91 have been added as courtesies – see below).

Claims 27-80 and 106-152 are withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 81-105 and 153-156 rejected under 35 U.S.C. 103(a) as being unpatentable over Vicknair et al. (hereinafter Vicknair - US 2003/0208421 A1) in view of Bellinger et al. (hereinafter Bellinger - US 5,870,725), Admitted Prior Art (APA).

Re. Claim 1, Vicknair discloses receiving from a sending financial institution at a first time a plurality of electronically presented items [paragraph 06 “The transmitting institution creates the ECP ... and transmits the electronic file 15 to the drawee bank.”], wherein one or more of the items received is comprised of a source key [see ISN] generated by a sender of the electronically presented items and transaction data associated with the source key [see entire document which

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is relevant to particularly, Abstract; Figures 1-2, 5 (#250); paragraphs 06, 08 ¹(entries for each item in the ECP includes unique ISN or say "ISN1"), paragraphs 15-20 (ECP), 26-28; claims 5-6 (key)² – "generated by a sender of the electronically presented items" is obvious see paragraph 20];

for each item received at the first time, assigning an electronic item presentment (EIP) sequence number to the item, associating the item's transaction data with the item's EIP sequence number, and associating the item's EIP sequence number with the item's source key [paragraphs 10-11 (each of the physical items are assigned another unique ISN or say "ISN2" and printed on the microfilm or image and cross reference file is built to correlate the ISN1 and ISN2), 37-38 (ISN)];

receiving from a sending financial institution³ at a second time image data **in a digitized format** for one or more of the items received the first time, wherein the image data for each item received at the second time is associated with the item's source key [paragraphs 20, 31, 34 – **see digital image which means in digital format**]; and

for each item received at the second time, associating the item's image sequence number with the item's EIP sequence number by matching (i) the source key associated with the item's EIP sequence number received at the first time with (ii) the source key associated with the item's

¹ paragraph 8 "**One end product of ... ECP ...is ... database.** The MICR line information, the date the item was posted to the drawee's account and an Item Sequence Number (ISN). **As the items of the ECP are processed in the stand processing procedure, they are each assigned a unique Item Sequence Number (ISN).**"

² paragraph 18 "**As the digital image of the check is electronically linked to the data records, the image thus carries the posting date and ISN of the ECP item.**"

³ "6. The method according to claim 5, wherein the key is selected from the **group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number** and a payor bank number, each being associated with the paper-based banking transaction." Also see specification paragraph 39 "source key".

³ paragraph 20 "**In an alternating embodiment of the present invention, the transmitting bank undertakes the task of imaging the physical items and transmitting to the receiving bank an enhanced ECP file. The enhanced ECP file contains all of the data regarding the ECP items that were traditionally included in the ECP, but also contains the images of the physical items linked to the data records...**" Also see Specification paragraphs 02-03 (Background of the Invention or APA).

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image sequence number received at the second time [paragraphs 11; claim 1], **wherein the matching step is performed by an electronic item presentment computer [inherent - see paragraphs 08, 41 “electronic database”, and “ECP processing ... computer files” which means the process is done by computer]**.

Vicknair does not explicitly disclose

for each item received at the second time, assigning an image sequence number to the item, associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key **to preserve a linkage integrity between the item and the item's image data.**

However, Rational database such as: IBM DBII, Oracle 8i, MySQL, Sybase, etc are well-known and they use SQL for manipulate database data and by assigning a primary key (item or row must be unique and can use all columns to generate a primary key), secondary key, foreign key to keep referential integrity between tables or correlating the records, index for fast searching, etc.

Further, Check Truncation Act (CTA) is known where a check truncation occurs when a bank retains an original check and presents the check via an electronic image or other electronic transmission. In order to present (transmit) electronic image to the drawee bank, the deposit bank has to track the check it is obvious that a database or mechanism should exist to correlate the check image or actual check with electronic cash letter (ECL) or checking account for fast retrieval (tracking) of the check image in the future or further processing of payment system.

Bellinger discloses for each item received at the second time, assigning an image

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sequence number to the item (image identification key), associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key (MICR data) and **to preserve a linkage integrity between the item and the item's image data** [Abstract; Figures 5, 20-22; col. 6 lines 15-25, col. 12 lines 14-20; col. 15 lines 1-4; **col. 5 lines 5-12, col. 19 lines 40-44 (cross reference obviously preserves the linkage integrity between related data)**] and further Bellinger also discloses **matching step is performed by an electronic item presentment computer (computer) [col. 14 lines 9-41]**.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include for each item received at the second time, assigning an image sequence number to the item (image identification key), associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key as disclosed by Bellinger to provide check image and electronic check code line MICR data in a useful and manipulative format (such as digital file on CD or online download) and the user is enabled to index the data and cross-reference digital image of an item with check record (MICR) in more cost efficient manner using computer.

Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.

Re. Claims 2-11, Vicknair discloses wherein the source key is comprised of a source sequence number, a source identifier and a source processing date [paragraph 8, claims 5-6];

wherein the source key is *stored* in an archive **in a non-volatile memory** in association with the EIP sequence number [paragraphs 10, 14, 42 – non-volatile memory is obvious, see digital archive which has to be non-volatile memory];

wherein the image sequence number is *stored* in the archive in association with the EIP sequence number [paragraph 13].

Bellinger further discloses wherein an image key is *stored* in the archive in association with the EIP sequence number and the image key is comprised of the image sequence number, a capture date and a capture cycle;

wherein the image data is *stored* in an archive in **non-volatile memory** in association with the EIP sequence number; wherein the image data is *stored* in an archive in association with the source key;

wherein the image data is *stored* in an archive in association with the image sequence number; wherein the image data is *stored* in an archive in association with an image key; and

wherein the image key is comprised of the image sequence number, a capture date and a capture cycle [Figures 20-22; col. 12 lines 10-20; col. 6 lines 43-49] and

non-volatile memory [col.6 lines 43-49 - to store data on CD-ROM more cost effectively].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Vicknair, and Bellinger and include the above feature to index the check information using image key and allow the user to retrieve the check information from database using image identification as a retrieval key and store the data no non-volatile memory such as CD-ROM cost effectively.

Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognize that the results of the combination were predictable.

Re. Claim 12, Vicknair discloses for each of the items to which an EIP sequence number has been assigned, posting the item's transaction data to a posting system and associating the item's posted transaction data with the item's EIP sequence number [paragraphs 06-07].

Re. Claims 13-26, Bellinger further discloses for each of the items to which an EIP sequence number has been assigned, posting at least some of the item's transaction data to a posting system and associating the item's posted transaction data with the item's EIP sequence number [Figures 20-22 and associated descriptions; col. 2 lines 52-61; col. 13 line 55 through col. 14 line 26];

wherein the item's posted transaction data is *stored* in an archive in **non-volatile memory** in association with the item's EIP sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's source key; wherein the item's posted transaction data is *stored* in an archive in association with the item's image sequence number; wherein the item's posted transaction data is *stored* in an archive in association with an image key; wherein the image key is comprised of the image sequence number, a capture date and a capture cycle; wherein the posting system is pre-existing (business choice); assigning a posting sequence number to each item posted; and associating the item's posting sequence number with the item's posted transaction data; wherein the item's posted transaction data is *stored* in **non-volatile memory** in an archive in association with the item's posting sequence number; wherein

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the item's posted transaction data is *stored* in an archive in association with the item's EIP sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's source key; wherein the item's posted transaction data is *stored* in an archive in association with the item's image sequence number; wherein the item's posted transaction data is *stored* in an archive in association with an image key; and wherein the image key is comprised of the image

sequence number, a capture date and a capture cycle [Figures 20-22; col. 12 lines 10-20; col. 3 lines 25-31; col. 4 lines 13-35] and **non-volatile memory [col.6 lines 43-49 - to store data on CD-ROM more cost effectively]**. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Vicknair, and Bellinger and include the above feature, as disclosed Bellinger by posing and storing of the items with image identification number crossed reference with EIP sequence number, account number, etc to make it possible for indexing the item with different keys/fields which may serve as an effective way to retrieve the item if only a limited information is known about the item.

Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.

Re. Claims 81, 153-156 are rejected with same rational as claim 1 (Vicknair in view of Bellinger, and APA).

Re. Claims 82-105, are rejected with same rational as claims 2-26.

Response to Arguments

5. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection. See the rejection of the claims, above.

In response to teaching away see MPEP § 2141.02 and § 2143.01, the court's opinions in *W.L. Gore & Associates v. Garlock, Inc.*, and *In re Gurley*. The concept of "teaching away" has technical foundations and requirements of a limited, narrow technical nature of a common sense variety. In this case, It becomes clear that, contrary to Appellant's assertion, generating ECP or EIP and transmitting ECP and check image (see the prior art disclosed by Vicknair, particularly, paragraph 20) by the sender not cited in the reference as teaching away in a manner relevant to the specific use of the disclosures are moot. There are no disclosures in secondary reference(s) that prohibit the modification of Vicknair's disclosures from being modified to meet Appellant's limitations. The Vicknair disclosure involves directly an analogous art to that of Appellant's invention and the modifications would not disable Vicknair's teachings.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kyle Charles can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3695

Sunday, August 15, 2010